

REMARKS

In the Office Action mailed April 25, 2007 (hereafter, "Office Action"), the Office Action rejected claims 42-46 under 35 U.S.C. § 102. The Office Action also rejected claims 1-5, 9, 11-15, 18-22 and 27-41 under 35 U.S.C. § 103. Claims 29, 36, 39, 42 and 45 have been amended.

Applicants respectfully respond to this Office Action.

I. Claims 42-46 Rejected under 35 U.S.C. § 102

The Office Action rejected claims 42-46 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,802,149 to Hanson (hereinafter, "Hanson"). This rejection is respectfully traversed.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 (citing Verdegaal Bros. v. Union Oil Co. of California, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). "The identical invention must be shown in as complete detail as is contained in the ... claim." Id. (citing Richardson v. Suzuki Motor Co., 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)). In addition, "the reference must be enabling and describe the applicant's claimed invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention." In re Paulsen, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

Applicants respectfully submit that the claims at issue are patentably distinct from Hanson. Hanson does not disclose all of the limitations in these claims.

Claim 42 has been amended to recite "checking whether a feature of said wireless communication device has previously been utilized, wherein said checking is performed by said wireless communication device." Support for this amendment may be found in Applicants' specification, for example, page 5, lines 3-5; page 6, lines 17-20 and page 10, lines 21-31. Hanson does not disclose this claim element.

The Office Action points to Figure 2, reference number 208 to support the assertion that "Hanson teaches checking whether a voice tag saving or voice dialing feature . . . of the wireless communication device has previously been utilized." Office Action, page 3. Reference number

208 of Hanson states “match received tag against tags in voice-dialing directory.” Hanson, Figure 2, reference number 208. However, reference number 208 is not “performed by said wireless communication device” as claimed by Applicants. Instead, Hanson states:

Upon receipt of the tag, at step 204, system 107 stores the received tag, at step 206, and then searches the caller's voice-dialing directory 130 in an attempt to match the received tag with one of the tags stored in voice-dialing directory 130, at step 208.

Hanson, col. 3, lines 59-63.

The above-cited portion of Hanson discloses that “system 107 . . . searches the . . . directory in an attempt to match the received tag . . . at step 208.” Id. The system 107 is not a “wireless communications device.” Rather, regarding the system 107, Hanson states:

A voice-dialing system 107 that is connected as an adjunct processor to switching center 104 provides users of telephones 100-101 with voice-dialing capability. Voice-dialing system 107 is illustratively an interactive voice-response unit (IVRU) such as the Lucent Technologies Inc. Conversant® system. System 107 is a stored-program-controlled unit that includes a processor 111 for executing control programs 121 which are stored in a memory 112.

Hanson, col. 3, lines 26-33.

“A voice-dialing system . . . that . . . provides users of telephones . . . with voice-dialing capability” does not disclose a “wireless communication device.” Instead, the “[v]oice-dialing system . . . is . . . and interactive voice response unit.” An “interactive voice response unit” does not disclose “a wireless communication device.” In fact, the Office Action asserts that “Hanson discloses that a voice dialing system 107 provides users of telephones [i.e., wireless communication device] with voice dialing capability.” Office Action, page 3. As such, the Office Action only asserts that the telephones in Figure 1 of Hanson disclose “a wireless communication device.”

The Office Action has not pointed to, and Applicants cannot find, any disclosure by Hanson of the “voice-dialing system” being a telephone (i.e., a wireless communication device). For example, Hanson states “system 107 is connected to switching center 104 (and therethrough selectively to telephones 100-101.” Hanson, col. 3, lines 36-37. Here, Hanson discloses that the “voice dialing system” is not a telephone (wireless communication device) because the system “is connected . . . to [the] telephone.” Id. In addition, Figure 1 of Hanson clearly shows the

telephones 100, 101 (wireless communication devices) being distinct and separate from the voice dialing system 107. See Hanson, Figure 1.

In view of the foregoing, Applicants respectfully submit that claim 42 is patentably distinct from Hanson. Accordingly, Applicants respectfully request that the rejection of claim 42 be withdrawn.

Claims 43-44 depend directly from claim 42. Accordingly, Applicants respectfully request that the rejection of claims 43-44 be withdrawn for at least the same reasons as those presented above in connection with claim 42 because Hanson does not disclose all of the claim elements of claim 42.

Claim 45 has been amended to recite “checking whether a first feature of said wireless communication device has previously been utilized, wherein said checking is performed by said wireless communication device.” This amended claim element is similar to the amended claim element of claim 42. As such, Applicants respectfully submit that claim 45 is patentably distinct from Hanson for at least the same reasons as those presented above in connection with claim 42. Accordingly, Applicants respectfully request that the rejection of claim 45 be withdrawn.

Claim 46 depends directly from claim 45. Accordingly, Applicants respectfully request that the rejection of claim 46 be withdrawn for at least the same reasons as those presented above in connection with claim 45 because Hanson does not disclose all of the claim elements of claim 45.

II. Claims 1-5, 11, 13-14, 18-22 and 27 Rejected under 35 U.S.C. § 103

The Office Action rejected claims 1-5, 11, 13-14, 18-22 and 27 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5, 978,671 to Foladare et al. (hereinafter, “Foladare”) in view of U.S. Patent Publication No. 2003/0190020 to Kitchings (hereinafter, “Kitchings”) further in view of U.S. Patent No. 4,994,983 to Landell et al. (hereinafter, “Landell”). This rejection is respectfully traversed.

The factual inquiries that are relevant in the determination of obviousness are determining the scope and contents of the prior art, ascertaining the differences between the prior art and the claims in issue, resolving the level of ordinary skill in the art, and evaluating evidence of secondary consideration. KSR Int'l Co. v. Teleflex Inc., 550 U.S. ___, 2007 U.S. LEXIS

4745, at **4-5 (2007) (citing Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18 (1966)). To establish a *prima facie* case of obviousness, the prior art references “must teach or suggest all the claim limitations.” M.P.E.P. § 2142. Moreover, the analysis in support of an obviousness rejection “should be made explicit.” KSR, 2007 U.S. LEXIS 4745, at **37. “[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Id. (citing In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Applicants respectfully submit that the claim at issue is patentably distinct from the cited references. The cited references do not teach or suggest all of the limitations in these claims.

Claim 1 recites “prompting the user with a second prompt for a second voice tag corresponding to said first telephone number when said first voice tag corresponding to any telephone number has already been saved.” Foladare, alone or in combination with Kitchings or Landell, does not teach or suggest this claim element.

Instead Foladare states:

The subscriber is given the opportunity to listen to those caller audible identifiers that are determined to originate from possible repeat callers as well as the corresponding stored audible identifier, and determine if they are from the same caller. If the subscriber indicates that the audible identifiers originated from the same caller, then both audible identifiers are stored with the corresponding entered alphanumeric identifier.

Foladare, col. 7, lines 38-45.

Giving the subscriber “the opportunity to listen to those caller audible identifiers that are determined to originate from possible repeat callers as well as the corresponding stored audible identifier” does not teach or suggest “prompting the user with a second prompt for a second voice tag.” The subscriber in Foladare simply listens to the caller audible identifiers. At no time does the subscriber in Foladare receive “a second prompt for a second voice tag” as claimed by Applicants. The subscriber merely “listen[s] to those caller audible identifiers . . . and indicates [whether] the audible identifiers originated from the same caller.” Id. Listening to the caller audible identifiers and indicating whether the identifiers originated from the same caller does not teach or suggest “prompting the user with a second prompt for a second voice tag corresponding to said first telephone number when said first voice tag corresponding to any telephone number has already been saved.”

Foladare also states “the caller can be prompted to speak a word or phrase such as the caller's name.” Foladare, col. 6, lines 61-62. However, there is no teaching or suggestion that the caller is “prompt[ed] . . . with a second prompt for a second voice tag.” In fact, this cited passage of Foladare is the first occurrence taught by Foladare of prompting “the caller . . . to speak a word or phrase.” *Id.* Further, Foladare does not teach or suggest that the caller is prompted “with a second prompt for a second voice tag when said first voice tag corresponding to any telephone number has already been saved.” Instead, Foladare states that the caller is prompted (for the first time) upon “obtaining the caller identity information.” Foladare, col. 6, line 60.

The addition of Kitchings and Landell does not overcome the deficiencies of Foladare. The Office Action merely points to Kitchings to support the assertion that “Kitchings teaches saving voice tag within the wireless communication device.” Office Action, page 6. The Office Action also simply points to Landell to support the assertion that “Landell teaches prompting the user a third prompt for a new phrase . . . if a recognition . . . quality of the corresponding phrase does not satisfy a quality parameter.” Office Action, page 7. The Office Action does not point to, and Applicants cannot find, any teaching or suggestion by Kitchings or Landell of “prompting the user with a second prompt for a second voice tag corresponding to said first telephone number when said first voice tag corresponding to any telephone number has already been saved.”

In view of the foregoing, Applicants respectfully submit that claim 1 is patentably distinct from Foladare, Kitchings and Landell, alone or in combination. Accordingly, Applicants respectfully request that the rejection of claim 1 be withdrawn.

Claims 2-5, 11, and 13-14 depend either directly or indirectly from claim 1. Accordingly, Applicants respectfully request that the rejection of claims 2-5, 11, and 13-14 be withdrawn for at least the same reasons as those presented above in connection with claim 1 because Foladare, Kitchings and Landell, alone or in combination, do not teach or suggest all of the claim elements of claim 1.

Claim 18 recites “to prompt the user to save a second voice tag corresponding to said first telephone number when a first voice tag corresponding to any telephone number has already been saved.” This claim element is similar to the claim element of claim 1 provided above. As

such, Applicants submit that claim 18 is patentably distinct from Foladare, alone or in combination with Kitchings or Landell, for at least the same reasons as those provided above in connection with claim 1. Accordingly, Applicants respectfully request that the rejection of claim 18 be withdrawn.

Claims 19-22 and 27 depend directly from claim 18. Accordingly, Applicants respectfully request that the rejection of claims 19-22 and 27 be withdrawn for at least the same reasons as those presented above in connection with claim 18 because Foladare, Kitchings and Landell, alone or in combination, do not teach or suggest all of the claim elements of claim 18.

III. Claims 9 and 15 Rejected under 35 U.S.C. § 103

The Office Action rejected claims 9 and 15 under 35 U.S.C. § 103(a) as being unpatentable over Foladare in view of Kitchings, further in view of Landell, further in view of U.S. Patent No. 5,982,857 to Brady (hereinafter, "Brady"). This rejection is respectfully traversed. The standard to establish a *prima facie* case of obviousness is provided above.

Claims 9 and 15 depend either directly or indirectly from claim 1. Accordingly, Applicants respectfully request that the rejection of claims 9 and 15 be withdrawn for at least the same reasons as those presented above in connection with claim 1 because Foladare, Kitchings, Landell and Brady, alone or in combination, do not teach or suggest all of the claim elements of claim 1.

IV. Claims 12 and 28 Rejected under 35 U.S.C. § 103

The Office Action rejected claims 12 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Foladare in view of Kitchings, further in view of Landell, further in view of U.S. Patent No. 5,898,392 to Bambini et al. (hereinafter, "Bambini"). This rejection is respectfully traversed. The standard to establish a *prima facie* case of obviousness is provided above.

Claim 12 depends indirectly from claim 1. Accordingly, Applicants respectfully request that the rejection of claim 12 be withdrawn for at least the same reasons as those presented above in connection with claim 1 because Foladare, Kitchings, Landell and Bambini, alone or in combination, do not teach or suggest all of the claim elements of claim 1.

Claim 28 depends indirectly from claim 18. Accordingly, Applicants respectfully request that the rejection of claim 28 be withdrawn for at least the same reasons as those presented above in connection with claim 18 because Foladare, Kitchings, Landell and Bambini, alone or in combination, do not teach or disclose all of the claim elements of claim 18.

V. Claims 29-41 Rejected under 35 U.S.C. § 103

The Office Action rejected claims 29-41 under 35 U.S.C. § 103(a) as being unpatentable over Hanson in view Kitchings. This rejection is respectfully traversed. The standard to establish a *prima facie* case of obviousness is provided above.

Claim 29 has been amended to recite “checking whether said voice tag is a first voice tag to be saved at the wireless communication device, wherein said checking is performed by the wireless communication device.” Support for this amendment may be found in Applicants’ specification, for example, page 5, lines 3-5; page 6, lines 17-20 and page 10, lines 21-31. Hanson, alone or in combination with Kitchings, does not teach or suggest this claim element.

The Office Action points to Figure 2, reference number 210 to support the assertion that Hanson teaches “matching [i.e., checking] whether the voice tag is a first voice tag to be save.” Office Action, page 11. Reference number 210 of Hanson is a decision step that states “match found?” Hanson, Figure 2, reference number 210. However, the decision at reference number 210 is not “performed by the wireless communication device” as claimed by Applicants. Instead, Hanson states:

Upon receipt of the tag, at step 204, system 107 stores the received tag, at step 206, and then searches the caller's voice-dialing directory 130 in an attempt to match the received tag with one of the tags stored in voice-dialing directory 130, at step 208 . . . if a match is found, as determined at step 210, system 107 proceeds conventionally, at step 214, to cause switching center 104 to establish a call connection for the call to the tag's corresponding stored telephone number.

Hanson, col. 3, line 59-col. 4, line 3.

The above-cited portion of Hanson discloses that “system 107 . . . searches the . . . directory in an attempt to match the received tag . . . at step 208 . . . [and] if a match is found, as determined at step 210.” *Id.* The system 107 does not teach or suggest a “wireless communications device.” Rather, regarding the system 107, Hanson states:

A voice-dialing system 107 that is connected as an adjunct processor to switching center 104 provides users of telephones 100-101 with voice-dialing capability. Voice-dialing system 107 is illustratively an interactive voice-response unit (IVRU) such as the Lucent Technologies Inc. Conversant® system. System 107 is a stored-program-controlled unit that includes a processor 111 for executing control programs 121 which are stored in a memory 112.

Hanson, col. 3, lines 26-33.

“A voice-dialing system . . . that . . . provides users of telephones . . . with voice-dialing capability” does not teach or suggest a “wireless communication device.” Instead, the “[v]oice-dialing system . . . is . . . and interactive voice response unit.” An “interactive voice response unit” does not teach or suggest “a wireless communication device.” In fact, the Office Action asserts that “Hanson discloses that a voice dialing system 107 provides users of telephones [i.e., wireless communication device] with voice dialing capability.” Office Action, page 3. As such, the Office Action only asserts that the telephones in Figure 1 of Hanson teach or suggest “a wireless communication device.”

The Office Action has not pointed to, and Applicants cannot find, any teaching or suggestion by Hanson of the “voice-dialing system” being a telephone (i.e., a wireless communication device). For example, Hanson states “system 107 is connected to switching center 104 (and therethrough selectively to telephones 100-101.” Hanson, col. 3, lines 36-37. Here, Hanson teaches that the “voice dialing system” is not a telephone (wireless communication device) because the system “is connected . . . to [the] telephone.” *Id.* In addition, Figure 1 of Hanson clearly shows the telephones 100, 101 (wireless communication devices) being distinct and separate from the voice dialing system 107. See Hanson, Figure 1.

The addition of Kitchings does not overcome the deficiencies of Hanson. The Office Action merely points to Kitchings to support the assertion that “Kitchings teaches wherein a wireless communication device receives the voice tag and saving the voice tag at the wireless communication device.” Office Action, page 11. The Office Action does not point to, and Applicants cannot find, any teaching or suggestion by Kitchings of “checking whether said voice tag is a first voice tag to be saved at the wireless communication device, wherein said checking is performed by the wireless communication device.”

In view of the foregoing, Applicants respectfully submit that claim 29 is patentably distinct from Hanson and Kitchings, alone or in combination. Accordingly, Applicants respectfully request that the rejection of claim 29 be withdrawn.

Claims 30-35 depend either directly or indirectly from claim 29. Accordingly, Applicants respectfully request that the rejection of claims 30-35 be withdrawn for at least the same reasons as those presented above in connection with claim 29 because Hanson and Kitchings, alone or in combination, do not teach or suggest all of the claim elements of claim 29.

Claim 36 has been amended to recite “checking whether a first voice tag corresponding to any telephone number has already been saved at the wireless communication device, wherein said checking is performed by the wireless communication device.” This claim amendment of claim 36 is similar to the claim amendment of claim 29 provided above. As such, Applicants submit that claim 36 is patentably distinct from Hanson and Kitchings, alone or in combination, for at least the same reasons as those presented above in connection with claim 29. Accordingly, Applicants respectfully request that the rejection of claim 36 be withdrawn.

Claims 37-38 depend directly from claim 36. Accordingly, Applicants respectfully request that the rejection of claims 37-38 be withdrawn for at least the same reasons as those presented above in connection with claim 36 because Hanson and Kitchings, alone or in combination, do not teach or suggest all of the claim elements of claim 36.

Claim 39 has been amended to recite “checking whether a new voice tag is a first voice tag to be successfully saved at the wireless communication device, wherein said checking is performed by the wireless communication device.” Hanson, alone or in combination with Kitchings, does not teach or suggest this claim element. This claim amendment of claim 39 is similar to the claim amendment of claim 29 provided above. As such, Applicants submit that claim 36 is patentably distinct from Hanson and Kitchings, alone or in combination, for at least the same reasons as those presented above in connection with claim 29. Accordingly, Applicants respectfully request that the rejection of claim 39 be withdrawn.

Claims 40-41 depend directly from claim 39. Accordingly, Applicants respectfully request that the rejection of claims 40-41 be withdrawn for at least the same reasons as those presented above in connection with claim 39 because Hanson and Kitchings, alone or in combination, do not teach or suggest all of the claim elements of claim 39.

REQUEST FOR ALLOWANCE

In view of the foregoing, Applicants respectfully submit that all of the pending claims in the application are patentable. Accordingly, reconsideration and allowance of this application are earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Respectfully submitted,

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